

REMARKS/ARGUMENTS

Introduction:

No claims are amended, added, or newly canceled. Claims 26, 33, 35, 36, 41, 42, 48, 73-85, 87, 89-92, 94, 97-99, and 103-110 remain pending in the application. Applicants respectfully request reexamination and reconsideration of the application.

Double Patenting:

Claims 105, 106, 108, and 109 were rejected on the grounds of non-statutory obvious-type double patenting over claims 8-15 of US Patent No. 6,520,778 in view of US Patent No. 5,632,631 to Fjelstad et al. ("Fjelstad"), US Patent No. 5,177,438 to Littlebury et al. ("Littlebury"), and US Patent No. 3,648,355 to Shide et al. ("Shide"). Applicants will file a terminal disclaimer but would prefer to do so after all other issues regarding patentability have been resolved.

Obviousness:

Claims 26, 33, 36, 41, 42, 48, 73-99, and 103-110 were rejected as obvious in view of US Patent No. 5,810,609 to Faraci et al. ("Faraci") and one or more of Fjelstad, US Patent No. 5,476,818 to Yanof et al. ("Yanof"), Littlebury, and Shida. In addition, claims 26, 33, 36, 41, 42, 48, 73-99, and 103-110 were rejected as obvious in view of US Patent No. 5,811,982 to Beaman et al. ("Beaman") and one or more of Fjelstad, Shida, and Yanof, and Littlebury, and claims 107 and 110 were rejected as obvious in view of Beaman and US Patent No. 5,326,428 et al. to Farnworth et al. ("Farnworth"). Applicants respectfully traverse these rejections.

In rejecting independent claims 26 and 42, the PTO equated Faraci's asperities 320 and Beaman's plated bump 71 with the recited contact tip. The PTO acknowledged that neither Faraci's asperities 320 nor Beaman's plated bump 71 comprises palladium much less palladium cobalt. To make up for this deficiency in Faraci and Beaman, the PTO relied on Fjelstad, Yanof, and Littlebury, which the PTO alleged disclose contact tips made of palladium or a palladium alloy but not palladium cobalt. The PTO thus acknowledged that the combination of Faraci with Fjelstad, Yanof, and Littlebury as well as the combination of Beaman with Fjelstad, Yanof, and Littlebury do not teach contact tips comprising palladium cobalt.

To make up for this acknowledged deficiency in the foregoing combinations of prior art, the PTO alleged two theories: (1) it is per se obvious to replace palladium or palladium alloys in Fjelstad, Yanof, and Littlebury with palladium cobalt because Applicants allegedly did not specify advantages of palladium cobalt over palladium or other palladium alloys; and (2) Shida suggests utilizing palladium cobalt. Applicants assert that neither theory establishes a prima facie case of obviousness.

First, the PTO cannot establish a prima facie of obviousness merely by stating that advantages are not stated in the specification of the application, and indeed, the PTO cites no authority for such a rule. Rather, as set forth in the recently published "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," Federal Register Vol. 72, No. 195 (Oct 10, 2007) (the "KSR Guidelines"), "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (KSR Guidelines pp. 57519-20.) The KSR Guidelines specify seven rationales (A)-(G) for supporting an obviousness conclusion. That the specification does not specify advantages of the invention is not one of those rationales. Thus, the PTO's first theory of obviousness—that Applicants allegedly did not specify advantages of the invention in the specification—cannot support the PTO's conclusion of obviousness.

Second, it would not be possible—much less obvious—to substitute Shida's three-layer sheet (see Figure 1 of Shida) for either the asperities 320 of Faraci or the plated bump 71 of Beaman. For example, Faraci's asperities 320 are small protrusions from cantilevered contact arms 190, 200. A three-layer sheet like Shida's sheet is not equivalent to nor can it be substituted for small protrusions or asperities 320 on contact arms 190, 200. Likewise, a three-layer sheet like Shida's sheet is not equivalent to nor can it be substituted for Beaman's plated bump 71. Shida does not therefore support a finding of obviousness.

For at least the foregoing reasons, independent claims 26 and 42 are not obvious in view of Faraci or Beaman in combination with Fjelstad, Yanof, Littlebury, and Shida, and the rejection of those claims should therefore be withdrawn. The PTO relied on Farnworth—which was used solely in the rejections of dependent claims 107 and 110—for alleged teachings regarding tip shapes, which does not make up for the above-discussed deficiencies in Faraci or Beaman in combination with Fjelstad, Yanof, Littlebury, and Shida.

Claims 33, 35, 36, 41, 48, 73-85, 87, 89-92, 94, 97-99, and 103-110 depend from claim 26 or claim 42 and, at least because of that dependency, are also patentable over the prior art of record.

Conclusion:

In view of the foregoing, Applicants submit that all of the claims are allowable and the application is in condition for allowance. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 426-2106.

Respectfully submitted,

Date: December 17, 2007

By /N. Kenneth Burraston/

N. Kenneth Burraston

Reg. No. 39,923

Kirton & McConkie
P.O. Box 45120
Salt Lake City, Utah 84145-0120
Telephone: (801) 426-2106
Fax: (801) 321-4893